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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,581	05/10/2001	James L. Warmus	27600/M239A	6089

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MCCRACKEN AND FRANK  
200 W. ADAMS STREET  
SUITE 2150  
CHICAGO, IL 60606

EXAMINER

HONG, STEPHEN S

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 12/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/852,581

Applicant(s)

WARMUS ET AL.

Examiner

Stephen S. Hong

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 2178

### **Part III DETAILED ACTION**

1. This action is responsive to communications: amendment filed on September 8, 2003 to the application, filed on May 10, 2001, which is a Div of 08/802,337 filed 2/11/97, which is a C.P. of 08/478,397 filed 6/7/95, which is a C.P. of 08/724 filed 4/2/96; prior art, filed on September 17, 2001.
2. Claims 1-13 are pending in the case. Claim 1 is an independent claim.
3. The rejection of Claims 1-13 under 35 U.S.C. 103(a) as being unpatentable over de Heus et al, U.S. Pat. No. 5,390,354, 2/95 in view of Sumita et al., U.S. Pat. No. 5,907,836, 5/99 has been withdrawn pursuant to the Applicant's argument in the amendment.

#### ***Specification***

4. Examiner requests that Applicant review the application carefully for informalities including typographical errors.

#### ***Claim Rejections - 35 USC § 103***

5. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

**6. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over de Heus et al, U.S. Pat. No. 5,390,354, 2/95 in view of Nussbaum et al., U.S. Pat. No. 5,346,196, 9/94.**

As per independent claim 1, de Heus teaches the claimed method of assembling a book including:

specifying pagination information including an indication of whether a page is to be selectively included in the book; determining whether the page is to be assembled into the book based on the pagination information; and generating page description language instructions for production of the book in accordance with the pagination information (col.3, lines 25 to col.4, line 14).

However, de Heus does not explicitly disclose that the total number of pages is to be assembled into the book is less than the initial first number of pages stored. With respect to the missing limitation, Nussbaum provides the following pertinent teaching. Nussbaum teaches a custom book assembly and biding system that different combination of pages to be selectively included in the book assembly (col.1, lines 50+). Nussbaum points out that the customizations can be based on various different factors including, demographic information, geographic information, etc. (col.2, lines 3+). Note that Nussbaum teaches a use of a digital "codes" that stores that which pages are to be incorporated into the specific book (col.3, lines 50-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have used de Heus' printing system to the custom book assembly such as Nussbaum, since Nussbaum pointed out that the disclosed system allows the document to be assembled based on the specific customers or targets.

As per dependent claims 3, 4, 6, 7 and 10-12, de Heus further teaches:

- analyzing press commands directed to production of the book to determine whether the page is to be assembled into the book (col.3, lines 25-60, "The final book layout... can be printed directly on output devices... us[ing] Adobe TM Postscript ...[or] non-Postscript");

- the step of generating a pagination file having data representative of the pagination information (col.3, line 68, "commands are combined ...that can be interpreted...");

- wherein the pagination information includes a specification of wherein the page should be forced to one of a right side and a left side of the book (col.6, lines 8-28);

- wherein the method further include delivering the page description language instructions to an electronic press to print the book (col.3, line 39, "form a complete page image may be implemented either in the Host Publishing system or in a Digital Graphics..");

- the step of generating page description language instructions further comprises the step of generating instructions for insertion of filler pages in accordance with pagination information (col.5, line 31-62).

As per dependent claim 2, de Heus does not explicitly disclose analyzing variable information areas of the page. Nevertheless, as Applicant points out in the background section of the present application (e.g, on page 2), it was extremely well known in the art to provide variable information areas in a page of a book. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have included the step of analyzing the variable area in de Heus, since it would have allowed de Heus to process generating books that use the well known variable page processing techniques.

As per dependent claim 5, de Heus does not explicitly disclose that the pagination information includes an indication of a maximum number of pages for the book. Nevertheless, de Heus discloses including maximum display area per page, maximum filler, minimum filler (col.5, line 53+) and points out that the system recognizes the quantity of pages of the book (col.5, line 52). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have include the information of the maximum number of pages for the book, since de Heus suggested that the size limitation of the whole document must be determined by limiting other factors such as the filler page numbers.

As per dependent claims 8 and 9, although de Heus does not teaching using the barcode on the pages for the tracking information. The use of barcode for tracking document pages was extremely well known in the art. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have used the well known tracking means in the disclosed invention of multiple page document generation.

As per dependent claim 13, de Heus does not teach that the method include the step of providing a user interface for entry of the pagination information. Nevertheless, de Heus teaches the system in Figure 1 which accepts the pagination information from the Host interface. Since de Heus also teaches that the information is generated by the Host Publishing system (col.3, lines 25 +), it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have envisaged that the host system be provided with a means for the operator to input the data including the pagination data.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5,287,976 A      02-1994      Mayer et al      209/547

9. As Applicant points out on page 4 of the amendment, Sumita et al. reference appears less "analogous art" with respect to the de Heus et al. According, the previous rejections are withdrawn, and the new rejections are made with a clearly analogous art of Nussbaum et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen S. Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday to Friday, 9:00am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

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Stephen Hong  
Primary Examiner  
Art Unit 2178  
December 1, 2003